

## **REMARKS/ARGUMENTS**

The foregoing amendments in the specification and claims fully supported by the specification and claims as originally filed, and do not add new matter. The specification has been amended to delete references to embedded hyperlinks and/or browser-executable code. Further, the paragraph starting on page 374, line 32 of the specification has been amended to comply with the provisions of the Budapest Treaty.

Prior to the present amendment, Claims 58-63 were pending in this application. With this amendment, Claim 63 has been canceled without prejudice and Claim 58 has been amended to further clarify what applicants have always regarded as their invention. Support for the recitation of an "isolated" antibody is found in the specification at, for example, page 132, lines 29-38.

Claims 58-62 are pending after entry of the instant amendment. Applicants expressly reserve the right to pursue any canceled matter in subsequent continuation, divisional or continuation-in-part applications.

Applicants thank the Examiner for entering the preliminary amendments of October 16, 2001 and March 25, 2002.

### **I. Specification**

As requested by the PTO, Applicants have reviewed the application and deleted all references to embedded hyperlinks and/or browser-executable code. The ATCC address on page 372, line 34, has been amended and the paragraph beginning at page 374, line 32, has been amended to comply with the provisions of the Budapest Treaty. Additionally, the status of the prior US application 09/918,585 (now abandoned) has been updated.

The title of the present application has been amended to clearly indicate the invention to which the claims are directed.

### **II. Information Disclosure Statement**

The Examiner has stated that the BLAST results cited in the Information Disclosure Statement submitted on March 25, 2002, have not been considered because the information on the referred databases is allegedly incomplete.

Applicants file herewith an Information Disclosure Statement listing each reference of the "BLAST Search" separately and including authors/inventors, database names, relevant accession numbers and publication dates. Applicants respectfully request that the listed information be considered by the Examiner and be made of record in the above-identified application.

### **III. Priority**

Applicants thank the Examiner for granting the priority date of the instant application as February 18, 2000.

### **IV. Claim Rejections Under 35 U.S.C. §103**

Claims 58-63 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Holtzman *et al.*, U.S. 2002/0055139, published May 9, 2002 with priority to May 14, 1999. Holtzman *et al.* teach a polypeptide (human A236 protein) that is 100% identical to SEQ ID NO:59. Holtzman *et al.* does not teach antibodies to the human A236 protein, but refers to several specific references for guidance on making the antibodies.

Applicants submit that the cancellation of Claim 63 renders the rejection of this claim moot.

Applicants respectfully submit a Declaration under 37 C.F.R. §1.131 by Dr. Desnoyers, Dr. Goddard, Dr. Godowski, Dr. Gurney and Dr. Wood that establishes that Applicants had cloned and sequenced SEQ ID NO:59, and determined the homology of the encoded polypeptide (SEQ ID NO:59) to the cell surface protein HCAR, before the prior art date of May 14, 1999. The consideration of the Declaration is respectfully requested.

*Applicants respectfully submit that an executed copy of the Declaration will be submitted to the Examiner shortly.*

### **Applicants Need to Disclose Only What is Disclosed in the Cited Reference to Support the Priority Claim**

Applicants respectfully submit that in order to remove the published patent application by Holtzman *et al.* as prior art under 35 U.S.C. §102, the Declaration by Dr. Desnoyers, Dr. Goddard, Dr. Godowski, Dr. Gurney and Dr. Wood ("Declaration") simply needs to provide a disclosure commensurate in scope with the disclosure in the prior art document by Holtzman *et al.* to support the priority claim.

In order to remove a reference as a prior art, “[i]t is sufficient if [the affidavit under Patent Office Rule 131] shows that as much of the claimed invention as is taught in the reference has been reduced to practice by the [patentee] prior to the date of the reference.”<sup>1</sup> In *In re Stempel*, the patent applicant (Stempel) had claims directed to both (i) a particular genus of chemical compounds (the “generic” claim) and (ii) a single species of chemical compound that was encompassed within that genus (the “species” claim). In support of a rejection under 35 U.S.C. §102, the examiner cited against the application a prior art reference that disclosed the exact chemical compound recited in the “species” claim. In response to the rejection, the patent applicant filed a declaration under 37 C.F.R. §1.131 demonstrating that he had made that specific chemical compound prior to the effective date of the cited prior art reference. The Court found the applicant’s 37 C.F.R. §1.131 declaration effective for swearing behind the cited reference for purposes of both the “species” claim and the “genus” claim. Specifically, the Court stated in support of its decision that “all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference.”<sup>2</sup>

Furthermore, the Examiner is respectfully directed to *In re Moore*, 170 USPQ 260 (CCPA 1971), where the holding in *In re Stempel* was affirmed. In *In re Moore*, the patent applicant claimed a particular chemical compound in his patent application and the examiner cited against the applicant a prior art reference under 35 U.S.C. §102 rejection which disclosed the compound but did not disclose any specific utility for the compound. The patent applicant filed a declaration under 37 C.F.R. §1.131 demonstrating that he had made the claimed compound before the effective date of the cited prior art reference, even though he had not yet established a utility for that compound. On appeal, the Court indicated that the 131 declaration filed by the patent applicant was sufficient to remove the cited reference. The Court relied on the established “Stempel Doctrine” to support its decision, stating:

An applicant need **not** be required to show [in a declaration under 37 C.F.R. §1.131] any more acts with regard to the subject matter claimed that can be carried out by one of ordinary skill in the pertinent art following the description contained in the reference ... the determination of a practical utility when one is

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<sup>1</sup> *In re Stempel*, 241 F.2d 755, 757 (1957).

<sup>2</sup> *Id.* at 759.

not obvious need **not** have been accomplished prior to the date of a reference unless the reference also teaches how to use the compound it describes.

*In re Moore*, 170 USPQ at 267 (emphasis added).

Thus, *In re Moore* confirmed the holding in *In re Stempel* which states that in order to effectively remove a cited reference with a declaration under 37 C.F.R. §1.131, **an applicant need only show that portion of his or her claimed invention that appears in the cited reference.**

As the Examiner noted, Holtzman *et al.* discloses a polypeptide (human A236 protein) that is 100% identical to SEQ ID NO:59. Holtzman *et al.* discloses that human A236 shares homology to CAR. Although Holtzman *et al.* includes general statements regarding possible uses of the sequence, no specific examples or experimental data are provided regarding the use of human A236.

Applicants respectfully submit that since Holtzman *et al.* only disclose a polypeptide sequence, its encoding nucleic acid sequence, and a sequence homology, without any disclosure to support utility, the Declaration simply needs to show possession of the polypeptide sequence and its encoding polynucleotide sequence as well as a sequence homology, as disclosed in Holtzman *et al.*, in order to remove the reference as prior art under 35 U.S.C. §102.

Applicants respectfully submit that U.S. Provisional Application Serial No. 60/078,910 filed on March 20, 1998, provides the nucleic acid and amino acid sequences of the PRO363 polypeptide.

The Declaration clearly states that U.S. Provisional Application Serial No. 60/078,910 filed on March 20, 1998 discloses sequences designated as SEQ ID NO:1 and SEQ ID NO:3, which are identical to SEQ ID NO:58 and SEQ ID NO:59, respectively, of the above-identified application. U.S. Provisional Application Serial No. 60/078,910 further discloses that the full length PRO363 polypeptide (SEQ ID NO:59) has significant homology to the cell surface protein HCAR.

Accordingly, Applicants respectfully submit that the disclosures are commensurate in scope and that U.S. Provisional Application Serial No. 60/078,910 discloses all that the cited prior art discloses.

Consequently, based on the holdings of *In re Stempel* and *In re Moore*, Holtzman *et al.* is not prior art under §102 since its effective priority date is after the invention by the Applicants for patent. As such, Holtzman *et al.* is not a proper reference under any section of 35 U.S.C. §102. Therefore, Holtzman *et al.* is not available to support a rejection under 35 U.S.C. §103.

In view of the foregoing arguments, withdrawal of the rejection of Claims 58-62 under 35 U.S.C. §103(a) over Holtzman *et al.* is respectfully requested.

### CONCLUSION

In conclusion, the present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned agent at the telephone number shown below.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-2630 P1C25).

Respectfully submitted,

Date: September 29, 2005

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